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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,916	06/21/2001	Denis O'Leary	72167.000305	6660
21967 7590 02/11/2008 HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109			EXAMINER KESACK, DANIEL	
			ART UNIT 3691	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/886,916

**Applicant(s)**

O'LEARY ET AL.

**Examiner**

Daniel Kesack

**Art Unit**

3691

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-88 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-88 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 31, 2007 has been entered.

### ***Status of Claims***

2. Claims 1-88 are currently pending.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 1, 43, 61, and 75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the newly added limitation "without account information of the customer" is unclear. Examiner is unable to determine what Applicant considers to be "account information of the first customer." Examiner considers that "account information" could be broadly interpreted as any information in a user's account, such as a customer's name, mailing address, e-mail address, financial institution, account number, transaction number, etc. Applicant's specification, including the parts which Applicant pointed to as providing support for said limitations, does not clearly point out what is *not* transmitted.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-12, 14, 16, 19-21, 23, 24, 26, 27, 29-45, 47-59, 61-86, and 88 are rejected under 35 U.S.C. 102(e) as being anticipated by Levchin et al., U.S. Patent No. 7,089,208.

Claim 1, 20, 21, 43, 77, 78, Levchin discloses a system and method for electronically exchanging value among distributed users, comprising:

an account system operated by a first institution, the account system maintaining electronic payment accounts for a plurality of customers of a first bank, at least one of the plurality of customers having a demand deposit account at the first bank (column 8 lines 38-47, column 12 lines 5-19);

a bank interface coupled to the at least one account system and coupled to the first bank, the bank interface transmitting and receiving financial information related to the demand deposit account of the at least one customer related to the electronic payment account of the at least one customer (figures 1, 3, and column 8 lines 38-47), the at least one account system funding the electronic payment account of the at least one customer from the demand deposit account of the at least one customer (column 4 lines 48-52 and column 5 lines 45-54); and,

a customer interface couple to the at least one account system, the customer interface providing an interface for the plurality of customers to the at least one account system, the customer interface accepting a command from a first customer to transfer funds from the first customer's electronic payment account to an electronic payment account of another customer, the customer interface transferring the command to at

least one account system which effectuates the commanded transfer (figure 3, column 9 lines 4-19) such effectuating of the commanded transfer of funds including a pushing of funds to the electronic payment account of the another customer (column 9 lines 4-19), wherein in such pushing, payee account number of the another customer, the payee, is transmitted over a network without account information of the first customer, the payor (column 6 lines 29-35). It is noted that within the context of Levchin, accounts may be identified by phone numbers, which would be a number that identifies the account, and may be considered to be an account number for these purposes.

Claim 2-6, 8, Levchin teaches the account system automatically funds customer's electronic payment account, in real time, by withdrawing funds from the customer's demand deposit account at the first bank, wherein the funding is triggered by the balance falling below a threshold (column 5 line 55 – column 6 line 3).

Claim 7, Levchin teaches the account is funded from a credit card (column 2 lines 36-44).

Claim 9, 47, Levchin teaches the funds are transferred through the Automated Clearing House system (column 5 lines 55-67).

Claim 10, 14, Levchin teaches automatically sweeping funds in the electronic payment account into a demand deposit account if a threshold is exceeded (column 5 line 55 – column 6 line 3).

Claim 11, Levchin teaches wherein at least one accounting system automatically sweeps funds as soon as they are received in the at least on customer's electronic payment account (column 8 lines 38-41).

Claim 12, Levchin teaches the account system automatically sweeps funds on a periodic basis (column 6 line 66 – column 7 line 15).

Claim 16, 24, Levchin teaches a secure connection coupling the bank interface and the first bank (column 6 lines 4-17).

Claim 19, Levchin teaches the financial institutions may or may not be external to the system (column 5 lines 55-57), and therefore it is inherent that the institution may be a second bank.

Claim 23, Levchin inherently teaches a plurality of additional account systems operated by the first institution, each of the plurality of additional account systems corresponding to a respective one of a plurality of additional banks, the plurality of additional account systems maintaining a second plurality of electronic payment

accounts for respective customers of the plurality of additional banks. As described above in regards to claim 1, Levchin teaches that the first institution may or may not be external to the bank at which a customer holds an account. Additionally, it is well within the scope of the Levchin invention, that a customer may hold a demand deposit account at a second bank, while registering an electronic payment account at a separate institution.

Claim 26, 27, 29, 44, 45, Levchin teaches information related to the demand deposit account and electronic payment account of a customer is transferred over the electronic funds transfer network (column 2 line 36-44).

Claims 30-33, 48-51, Levchin teaches a customer directory containing an identification of each of the plurality of customers and a correspondence between the identifications and the electronic payment accounts, and where the identification includes an email address, a nickname, and a phone number (column 16 lines 1-20).

Claims 34-42, 52-59, 62-64, 66-74, 79-86, Levchin teaches a request for payment is communicated through an email facility, wherein the potential payor does not have an electronic payment account, wherein the payment request comprises a link to the system, whereby the potential payor can satisfy the request for payment through the system, and wherein the potential payor satisfies the request for payment by



establishing an electronic payment account and making the requested payment (column 10 line 56 – column 11line 38, and column 13 line 15-25).

Claim 61, 65, 75, 76, Levchin teaches a payee directory, the payee directory containing at least one identification of the payee and a correspondence between the at least one identification and the payee account at the payee institution (column 8 lines 31-57), a first software component coupled to the payee directory, the first software component accepting the at least one identification and an amount of the payment from the payor, the first software component generating a payment instruction identifying the payee institution, the payee account, and an amount of the payment, and communicating the payment authorization to the payor institution (column 9 lines 4-19 and column 12 lines 55-67), and a second software component at the payor institution coupled to the first software component and coupled to the EFT network (figure 3) the second software component receiving the payment instruction and transmitting from the payor institution to the payee institution through the EFT network, and wherein the EFT credit message represents a credit in the amount of the payment (column 12 lines 5-35).

Claim 88, Levchin teaches the command from a first customer to transfer funds from the first customer's electronic payment account to an electronic payment account of another customer includes a payee account number of the payee (column 9 lines 28-31). Furthermore, Levchin teaches the identifier may be a number, such as a telephone

number or a social security number (column 3 lines 63-67), which would serve as the payee account number.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 13, 17, 18, 28, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levchin.

Claim 13, Levchin teaches sweeping funds on a periodic basis, but fails to teach the periodic basis group of daily, weekly, and monthly. Official notice is taken that daily, weekly, and monthly are old and well-known interpretations of the term "periodically,"

especially as it relates to financial transactions. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify "periodic" in the Levchin reference to include daily, weekly, and monthly.

Claims 17, 18, Levchin teaches a secure connection between the financial server and the banking server, but fails to teach the secure connection being a private network or a direct dial connection. Official notice is taken that private networks and direct dial connections are old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Levchin to include private networks and direct dial connections as secure connections because it is desirable that financial transactions conducted over networks involve a high level of security when sending and receiving data.

Claims 28, 46, Levchin fails to teach the EFT network is an Automated Teller Machine (ATM) network. Official notice is taken that ATM networks are old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Levchin to include ATM networks because financial institutions use ATM networks to conduct user transactions, due to the convenience and availability of ATMs to users, and it is desirable that the invention be integrated into already existing banking networks.

6. Claims 60, 74, and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levchin, as applied above, and further in view of Magness, U.S. Patent No. 6,769,605.

Levchin teaches a customer making a payment to a potential payee by establishing an electronic payment account and communicating a potential payment to the payment account. Levchin fails to teach a physical card linked to the potential payee electronic payment account wherein the physical card is sent to the potential payee.

Magness teaches a money transfer system in which payment is deposited into a payment account by a sender, and a physical card is sent to the payee, wherein the physical card may be used to access the payment account in order redeem or otherwise use the payment. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Levchin to include sending a physical payment access card to a potential payee because Levchin discloses the system may be used to transfer value from a customer who has an account to a customer who does not have an account, and it would be desirable that a potential payee not be required to obtain an account in order to receive payment, within the system described by Levchin.

7. Claims 15, 22, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levchin, as applied above, and further in view of Drummond et al., U.S. Patent No. 7,080,036.

Levchin fails to teach an interface configured such that when any of the customers of the plurality of additional banks access their respective account system, it appears that the customer's respective bank is operating the system.

Drummond teaches an automated banking machine development method, wherein a non-bank-specific banking interface is developed by an entity independent of the entity with which a customer holds an account, and wherein the customer is provided with interface outputs which suggests that the machine is one operated by the customer's particular bank or entity with whom they have an account relationship (column 14 lines 23-34). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Levchin to include transparency of the independent entity as described above because it is desirable to provide a customer with a familiar environment, including their bank's branding in order to build customer relationship and brand image.

### ***Response to Arguments***

8. Applicant's arguments filed October 31, 2007 have been fully considered but they are not persuasive.

Regarding the newly added limitations, see the rejection of claims 1, 43, 61, and 75, above.

Regarding Applicant's argument that the operation of system of Levchin does not constitute "pushing of funds," Examiner respectfully disagrees. Examiner is unaware of any art accepted definition of such a phrase, and is unable to find a clear definition in Applicant's specification. Therefore, Examiner has given the phrase its broadest reasonable interpretation to mean a payor actively paying a payee (as opposed to a payee requesting the funds be withdrawn from the payor account). Absent evidence that this interpretation is unreasonable in light of Applicant's specification, the payor initiating a transfer of funds is considered pushing the funds.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Kesack whose telephone number is (571)272-5882. The examiner can normally be reached on M-F, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Daniel Kesack  
February 3, 2008  
/D. K./  
Examiner, Art Unit 3691

/Hani M. Kazimi/  
Primary Examiner, Art Unit 3691